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44361/265288

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/271326

APPLICANT: Reebok International Limited

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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: J.W. FOSTER

CORRESPONDENT'S REFERENCE/DOCKET NO: 44361/265288

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Please provide in all correspondence:

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3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Reebok International Limited	:	BEFORE THE
Trademark:	J.W. FOSTER	:	TRADEMARK TRIAL
Serial No:	78/271326	:	AND
Attorney:	Martha Gayle Barber	:	APPEAL BOARD
Address:	Alston & Bird LLP 202 S. Tryon Street, Suite 4000 Charlotte, NC 28280	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the Trademark Examining Attorney's final refusal to register the proposed mark **J.W. FOSTER** on the ground that this mark is primarily merely a surname under Trademark Act Section 2(e)(4), 15 U.S.C. Section 1052(e)(4).

I. FACTS

On July 8, 2003, the applicant, Reebok International Limited, applied for registration on the Principal Register, asserting an intent to use in commerce pursuant to Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), the proposed mark **J.W. FOSTER** in typed form for "clothing, footwear and headwear."

In the first Office action, dated January 14, 2004, the examining attorney refused registration under Section 2(e)(4) of the Trademark Act, 15 U.S.C. Section 1052(e)(4), finding the proposed mark to be primarily merely a surname.¹ Clarification of the identification of goods was also required.

The applicant responded on July 19, 2004, amending the identification of goods to "footwear, headwear and clothing, namely, sportswear, sweatpants, sweatshirts, shirts, shorts, sweaters, slacks, socks, jackets, sweatsuits, jumpsuits, warm-up suits, shooting shirts, fleece tops, tank tops, polo shirts, pants, athletic bras, leggings, rainsuits, turtlenecks, bathing suits, vests, parkas, dresses, athletic uniforms, gloves, wrist bands, thermal underwear, infantwear, coveralls, and running suits," and arguing against the refusal under Section 2 (e)(4).

A final Office action was issued on August 18, 2004, as to the refusal under Section 2(e)(4). The applicant requested reconsideration of the final refusal on December 27, 2004, which was denied on January 31, 2005. The applicant then filed a notice of appeal on March 3, 2005.

¹ The possibility of amending the application to seek registration on the Supplemental Register was noted, pending the filing of an allegation of use in commerce by the applicant.

II. ARGUMENT

THE PROPOSED MARK **J.W. FOSTER** IS PRIMARILY MERELY A SURNAME, IN ACCORDANCE WITH EVIDENCE PRESENTED AND CURRENT CASE LAW

A. LEGAL ANALYSIS

Section 2(e)(4) of the Trademark Act bars registration if a mark is primarily merely a surname to the relevant purchasing public. *See In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985); *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (C.C.P.A. 1975).

(1) Burden of proof

The burden is initially on the examining attorney to establish a *prima facie* case that a mark is primarily merely a surname. The burden then shifts to the applicant to rebut this showing. *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986). TMEP §1211.02(a).

There is no rule as to the kind or amount of evidence necessary to make out a *prima facie* showing that a term is primarily merely a surname. This question must be resolved on a case-by-case basis. *See, e.g., In re Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986). TMEP §§1211.02 *et seq.* Here, the record comprises the results of an electronic database search which uncovered over 110,000 hits² for the surname “FOSTER” as well as the applicant’s admission that the name “FOSTER” used in its mark signifies the surname of a deceased man by the name of Joseph William Foster.

² See Office action, dated January 14, 2004.

The examining attorney has established a *prima facie* showing that “FOSTER” is primarily merely a surname. Relevant case law further establishes that the addition of the initials “J.W.” to “FOSTER” only further enhances its surname significance. *See infra*. Section II, A, 3.

The applicant has not rebutted the *prima facie* showing. As discussed in further detail below, the applicant’s arguments that **J.W. FOSTER** is a famous historical figure; that the use of the initials “J.W.” in the mark identifies a personal name and not a surname; and that the primary significance of “FOSTER” can not be as a surname because it may also be used as a first name, all fall short of rebutting the showing that the mark is primarily merely a surname.

(2) **J.W. FOSTER** is not a famous historical figure

Decisions concerning historical names generally draw a line between names which are so widely recognized that they are almost exclusively associated with a specific historical figure and are thus not considered primarily merely a surname, *e.g.* *Lucien Piccard Watch Corp. v. Crescent Corp.*, 314 F. Supp. 329, 165 USPQ 459 (S.D.N.Y. 1970) (DA VINCI not primarily merely a surname because it primarily connotes Leonardo Da Vinci), and names which are only semi-historical in character and thus can be perceived as primarily merely a surname, *e.g.*, *Frances Rothschild, Inc. v. U.S. Cosmetic Fragrance Marketing Corp.*, 223 USPQ 817 (N.D. Tex. 1983) (ROTHSCHILD held primarily merely a surname despite being the surname of a historical banking family); *In re Champion International Corp.*, 229 USPQ 550 (TTAB 1985) (MCKINLEY held primarily merely a surname despite being the surname of a deceased president). If it is a historical name at all, **J.W. FOSTER** falls into the latter category.

Any fame of J.W. FOSTER exists only within the applicant’s own corporate culture. The applicant did not supply any evidence of the fame or historical significance of J.W. FOSTER outside of its own use and advertising of the name in promoting its own line of shoes.

The applicant argued that “[t]o a runner, the name **J.W. FOSTER** has far greater fame and significance than the name/mark M.C. ESCHER” in the *Sachs* case.³ Applicant’s Brief, p.13. However, the applicant supplied no evidence of the relevance of the name **J.W. FOSTER** to current-day shoe purchasers outside of the applicant’s own promotion of this name, comprising the applicant’s own marketing materials, the transcript of a published interview with this person’s descendant, and a statement indicating that the “famous” shoes created by this person were worn by athletes at the 1924 Olympic games. The precise title and/or nature of the materials in which the interview and statement was made was not indicated by the applicant. The applicant alleged that this evidence “demonstrates the high degree of public visibility that the Foster family maintains,” yet another reference to the surname significance of “FOSTER.” Applicant’s Response to Office Action, dated July 19, 2004.

The examining attorney refuted this argument in the final Office action, and conducted her own search for historical references to **J.W. FOSTER**. Specifically, an Internet research for “**J.W. FOSTER**” and either “sneakers” or “running” (as the materials supplied by the applicant referred to “running pumps”) retrieved a total of only eleven (11) web pages using the GOOGLE® search engine. All references retrieved involve *the applicant’s own use of this name*. Also attached to the final Office action were copies of the total eight (8) articles retrieved using the NEXIS® news database. The identical search retrieved articles *about the applicant* and its use of the **J.W. FOSTER** name, a factual listing on basketball which mentioned that Joseph William Foster invented a type of running shoe in 1895, and articles for a man of the same name who serves as a city council member in Olympia, Washington.

With only one source of information *unrelated to the applicant* in existence concerning the **J.W. FOSTER** name and shoes, sufficient evidence does not exist indicating that this name

³ *Michael S. Sachs, Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132 (TTAB 2000).

identifies a famous historical figure. The applicant can not be the sole source of hype in an attempt to create the fame of a person and then try to claim that this person is a famous historical figure.

(3) Use of initials emphasizes the surname significance of J.W. FOSTER

The applicant's argument that the use of initials takes this mark out of the category of being just primarily merely a surname, and identifies instead a particular individual or personal name, is contrary to current legal precedent.

The addition of an initial or initials to a surname does not diminish the surname significance of the term, and may, in fact, emphasize the primary surname significance of the term. *Sears, Roebuck & Co. v. Watson*, 204 F.2d 32, 96 USPQ 360 (D.C. Cir. 1953), *cert. denied*, 346 US 829, 99 USPQ 491 (1953) (J.C. HIGGINS); *In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265 (C.C.P.A. 1953) (S. SEIDENBERG & CO'S.); *In re Piquet*, 5 USPQ2d 1367 (TTAB 1987) (N. PIQUET).

The controlling cases concerning a surname preceded by two initials are *Sears, Roebuck & Co. v. Watson*, 204 F.2d 32, 96 USPQ 360 (D.C. Cir. 1953) ("J.C. HIGGINS"), and *Michael S. Sachs, Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132 (TTAB 2000) (M.E. ESCHER).

In *Sears*, the refusal to register the typed mark J.C. HIGGINS was upheld by the Court of Appeals for the District of Columbia Circuit, noting that "the initials are not sufficient to prevent the mark from consisting of 'primarily merely a surname,'" and "[e]ven if it could be said, contrary to the reasoning of earlier cases ... that 'J.C. HIGGINS' is not *merely* a surname, it is principally merely a surname and, therefore, *primarily merely* so." *Sears*, 204 F.2d at 34 (emphasis added).

In *Sachs*, the Board held sufficient the extensive evidence that the primary significance of the proposed mark, M.C. ESCHER, is to identify the famous artist of that name. The Board held that this significance is distinguishable from the issue in cases such as the present one, namely, a

situation in which the addition of initials to a surname reinforces the surname significance of a non-famous name. The *Sachs* case is based on a mark which “in its entirety conveys the impression ... of the well known Dutch artist.” *Id.* at 1136.

The applicant speculated in its brief that the *Sachs* case may have been decided based on the fame of the mark M.C. ESCHER to relevant purchasers, or “because any member of the public, upon seeing a surname preceded by two initials, would perceive the same to be a personal name” rather than primarily merely a surname. Applicant’s Brief, p.7. However, such speculation is unwarranted, as the Board clearly explained that the mark identifies the well known Dutch artist.

Applicant argued that the “spectrum of protection afforded by current case law” is “quite confusing,” noting the different outcomes in the *Sears* and *Sachs* cases. Applicant’s Brief, p.7. The applicant further argued that “[n]o case discusses the level of proof necessary to move double initial cases from one category to another or whether that proof can be in a niche market.” Applicant’s Brief, p.7. However, the relevant case law does clearly distinguish the fame of a particular mark to relevant purchasers as opposed to a mark of no famous or historical significance.

The applicant also argued that **J.W. FOSTER** is a personal name that identifies a particular individual and not primarily merely a surname,⁴ citing to the *Ex parte Dallioux*, 83 USPQ 262 (Comm’r Pats. 1949) case. However, that case can easily be distinguished from the current case because the mark at issue in that case was “ANDREW DALLIOUX” (first and last name). The applicant here has specifically identified in its “historical figure” argument that Joseph William Foster is the actual personal name of the purported famous historical figure at issue, yet the proposed mark is **J.W. FOSTER** and not “Joseph William Foster.”

⁴ The examining attorney does not, as the applicant suggested, “take judicial notice of the fact that many individuals have given names comprising initials,” Applicant’s Brief, p.12, and it would be inappropriate for the Board to take judicial notice of such information. TBMP §§704.12(a) and 1208.04.

The applicant argued that the dissenting, not majority, opinion of the *In re Nelson Souto Major Piquet*, 5 USPQ2d 1367 (TTAB 1987) case should be followed here, in which the fact that the mark was presented in special form – as a handwritten signature – was highlighted as a strong factor in forming the dissenting opinion that the mark is not primarily merely a surname. 5 USPQ2d at 1369. The present mark is presented in typed form, with no claim to any particular stylization, much less the appearance of an individual’s handwritten signature, which clearly distinguishes the two cases.

The applicant also argued that FOSTER can be a given name, and cited as evidence thereof a list of seven (7) trademark registrations and applications. However, no evidence was presented to indicate that FOSTER GRANT, FOSTER WHEELER, FOSTER HIGGINS or FOSTER RAINEY were, in fact, personal names and not merely combinations of two surnames. No other evidence of this claim has been included in the record.

While it is also true that the word “foster” is used as a verb, it is clearly not used as a verb here because: (1) the applicant admitted the proposed mark is indicative of a particular person with the surname “FOSTER” in its historical figure argument, and (2) the addition of initials preceding “FOSTER” clearly show and enhance the surname significance thereof.

For the foregoing reasons, the relevant purchasing public would perceive J.W. FOSTER to be primarily merely a surname.

B. DISCLAIMER OF SURNAME AGAINST OFFICE PRACTICE

The applicant argued that the proposed mark must be perceived in its entirety, that the commercial impression of a mark is derived from it as a whole, and further argued against the dissection of the mark for examination purposes. Applicant’s Brief, p.11. Yet the applicant argued

that the Office should accept a disclaimer of “FOSTER” and allow registration of the mark on the Principal Register.

Office practice does not require or allow disclaimer of a surname. *Ex parte Norquist Products, Inc.*, 109 USPQ 399 (Comm'r Pats. 1956) (disclaimer of "NORQUIST" found unnecessary in application to register mark comprising "NORQUIST CORONET" on an oval background featuring a coronet, for tables and chairs) (“Section [2(e)(4)] of the statute does not contemplate the dissection of a composite mark to determine whether a word which constitutes an integral part of the mark is primarily merely a surname. Rather, it contemplates an examination of the mark in its entirety and an evaluation of the commercial impression created by the entire mark.”). *See* TMEP §1213.03(a).

Furthermore, the applicant’s arguments *against dissecting* the mark for examination purposes, and *for dissecting* the mark for disclaimer purposes, are inconsistent.

C. APPLICANT’S REQUEST TO OVERRULE THE *Sears* CASE

The applicant has requested that the Board overrule the *Sears* case cited by the examining attorney in support of the contention that a surname preceded by two initials remains primarily merely a surname. *See Ex parte Sears, Roebuck & Co.*, 87 USPQ 400 (P.O. Ex. Ch. 1950). However, this ruling in this case was upheld by the United States Court of Appeals for the District of Columbia Circuit in *Sears, Roebuck & Co. v. Watson*, 204 F.2d 32, 96 USPQ 360 (D.C. Cir. 1953), *cert. denied*, 346 US 829, 99 USPQ 491 (1953).

D. OPTION TO AMEND TO SEEK REGISTRATION ON THE SUPPLEMENTAL REGISTER

It should be noted that the Office is not forbidding registration of the mark. The applicant has the option of amending the application to seek registration on the Supplemental Register once

an acceptable amendment to allege use under 37 C.F.R. §2.76 is filed. Trademark Act Section 23, 15 U.S.C. §1091; 37 C.F.R. §§2.47 and 2.75(a); TMEP §§801.02(b), 815 *et seq.*, 816 *et seq.* and 1102.03. After using the mark in commerce for five or more years, the applicant may reapply to register the mark on the Principal Register pursuant to a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).

II. CONCLUSION

For the foregoing reasons, the refusal to register the proposed mark **J.W. FOSTER** on the Principal Register based on Section 2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4), because it is primarily merely a surname, should be affirmed.

Respectfully submitted,

/LGK/
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